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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/406,001	09/24/99	HIATT, JR. A	HTT-9901

TM11/1013

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EXAMINER	
CRAVER, C	
ART UNIT	**PAPER NUMBER**
2681	4

DATE MAILED: 10/13/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/406,001	Applicant(s) Hiatt, Jr.
	Examiner Charles Craver	Group Art Unit 2681

☒ Responsive to communication(s) filed on *Sep 11, 2000* .

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-20* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-20* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities:

2. In claim 1, line 11, the examiner recommends changing "address" to --addresses--, and inserting --wherein-- before "the" (second occurrence). Correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1, 2 and 5-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Pepe et al, US Pat 5,742,668.

Regarding claim 1,

Pepe discloses a system for transferring data comprising:

a portable wireless device (30)

a wireless communication system (54) capable of establishing a wireless communication link with the device

a wireline network (49) connected to the wireless network (see FIG 4)

a computer (22, see FIG 1) connected to the wireline network, the computer capable of sending data to the wireless device (col 5 lines 31-54, col 6 lines 28-35, col 23 lines 35-63), the computer inherently using software. Further, since the data may be in email format (col 3 lines 48-56), it is assumed that the data may comprise any information a user wishes to transfer, including but not limited to text, files, or a plurality of addresses. Lastly, the computer is not a part of the wireline or wireless networks (see FIGS 1 and 4).

Regarding claim 2,

Pepe discloses that said wireless device is a cellular device (col 1 lines 36-41).

Regarding claim 5,

Pepe teaches that the invention may utilize the internet (col 23 lines 40-46) and uses email as a messaging standard (col 3 lines 48-56, col 11 lines 3-6).

Regarding claims 6-9,

Pepe discloses a PDA which would inherently contain a program fro transferring the data. As for claims 7-9, since Pepe teaches a PDA which may send email to the computer (col 10 line 63-col 11 line 6), a situation in which a PDA user sends an email using said software requesting, for example, a telephone number, file, or selected addresses would be read as anticipating claims 7-9.

5. Claims 10-14, 16 and 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Mills, of record.

Regarding claims 10 and 11,

Mills discloses a method for transferring address information comprising

at a first electronic device (100 comprising computer 10), setting up a communication path between it and a second device, including a wireless and wireline portion (col 5 lines 14-40 see FIG 3), inherently comprising a step of selecting or using transfer software to do so and using or entering an address of said second device, and

transferring SIM information, including in part, a list of addresses from the second device to the first device (col 5 lines 41-57).

Further, Mills discloses that the first device may be a terminal (col 3 lines 16-21), and as such is read as not being a part of the wireless or wireline networks.

Regarding claim 12,

Mills further discloses that said data may be transferred from the first device to the second (col 3 lines 16-63).

Regarding claims 13 and 14,

Mills further discloses that said requested address data may comprise a file of address data (i.e. dial lists, col 1 lines 39-41), or an individual address (i.e. field) in the device memory, i.e. a credit card number (col 4 line 56-col 5 line 13).

Regarding claim 16,

Since the second device of the invention of Mills is a cellular telephone (col 1 lines 12-30), and uses SMS or USSD, it is inherent that it would be identified by its telephone number when a data request message is to be sent to it via said messaging protocols.

Regarding claim 18,

Mills discloses a computer (10) for performing a process, inherently via a program, comprising

requesting an address of an electronic device when an address is to be transferred,

establishing a communications link via a communications network with said device, and

receiving a plurality of addresses (col 5 lines 14-57).

Further, since it is disclosed that said request is in response to the actions of an operator, for example an airline agent, it would be inherent that such a request would be made via said software at said computer terminal (10) using, for example, an "address transfer" option.

Regarding claims 19 and 20,

Mills further discloses that said requested address data may comprise a file of address data (i.e. dial lists, col 1 lines 39-41), or an individual address (i.e. field) in the device memory, i.e. a credit card number (col 4 line 56-col 5 line 13).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al as applied to claim 1 above.

Regarding claim 3,

As shown above, Pepe discloses applicants invention of claim 1. However, Pepe does not specifically disclose that said network operates under a digital PCS wide area network protocol. However, such a feature was well known in the art at the time of the invention, and as such the examiner takes Official Notice of such a feature. It would have been obvious, noting Pepe's disclosure that the user may comprise a cellular terminal, that such a memory transfer method may be applied to a PCS wide area network, as it would allow the invention of Pepe to operate on new communication systems and standards.

Regarding claim 4,

While disclosing all of the limitations set forth in claim 1 as shown above, Pepe does not specifically recite that said network may operate according to a hypertext protocol. However, given that Pepe does disclose thus use of internet and email protocol (col 5 lines 5-13), it would have been obvious to one skilled in the art at the time of the invention to utilize HTTP as it is a common internet protocol for transferring data.

8. Claims 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills as applied to claim 10 above, and further in view of Günlük, of record.

While disclosing all of the limitations set forth in claim 1 as shown above, Mills does not specifically recite that said network may operate according to a hypertext (i.e. internet) protocol or an electronic mail protocol such that a URL or E-mail address is entered rather than a phone number to contact the wireless device.

Günlük discloses that it is useful in a wireless messaging system using, for example, SMS, to allow interoperability, that is, to operate the network such that SMS and other such messaging protocols may be translated into other protocols for messaging interoperability, said other protocols including electronic mail and TCP/IP (i.e. hypertext) (see FIG 2, col 3 lines 55-67). Therefore, it would have been obvious to one skilled in the art to add such a feature to Mills as it would offer a higher performance message routing method, and thus allow better access to the information present in the wireless device.

Response to Arguments

9. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's arguments filed 9-11-2000 with regards to claims 10-20 have been fully considered but they are not persuasive.

The applicant has amended claim 10 to recite that the first device is not a part of the wireline or wireless networks. However, said limitation is not sufficient to overcome the teachings of Mills. Since Mills teaches a first device which is a computer terminal, it is not construed as being a part of the wireline or wireless networks. Further, the applicant argues that Mills does not teach the use of software in the transfer of data, however, given that Mills teaches a computer terminal, the examiner upholds that the use of a program would be inherent in the invention of Mills. As to Mills teaching the use of such a system in an airline reservation scenario, Mills does not limit the invention to such a narrow scope; such a use of the invention is merely a single use of the data transfer method of Mills. Lastly, as to the combination of Gunluk and Mills, the use of HTTP and email for the transfer of data was well known at the time of the invention, as shown by Gunluk. Thus the examiner upholds the rejection of claim 15.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-9051, (for formal communications; please mark "EXPEDITED PROCEDURE")

Or:

(703) 305-9051 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Craver whose telephone number is (703) 305-3965.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost, can be reached on (703) 305-4778.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

CC
C. Craver
October 4, 2000

WAYNE D. BOST
SUPERVISORY PATENT EXAMINER
GROUP 2700